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EXAMINER	
EWALD, MARIA VERONICA	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Response to Arguments

Applicant's arguments filed May 8, 2008 have been fully considered but they are not persuasive. Applicant has argued that the secondary reference of Friesem, et al. (U.S. 6,850,544) fails to teach a switching element for changing the modal composition of the laser radiation which switches the modal composition of the emitted laser radiation between a first setting in which a fundamental Gauss mode is emitted and higher order modes are suppressed and a second setting in which the radiation contains additional higher modes and the overall power is increased. Applicant further argues that Friesem, et al. teach the use of different mode control elements, but does not teach a switching capability, such that switching during a process is desirable. The Examiner disagrees.

Applicant has cited several passages within the reference of Friesem, et al. that teach two mode control elements (28 and 29), which are fixed to the resonator, each selecting different modes, which may include one mode or a plurality of modes (column 12, lines 5 – 15). Thus, Applicant argues that because the mode control elements are fixed, the apparatus of Friesem, et al. does not have a switching capability during operation of the device, such that mode control element 28 or 29 is selected, respectively. Though true, Friesem also teaches an embodiment with *one mode control element* which is "operative to select one mode or set of modes of one polarization (column 16, lines 33 – 40)." *Here, one mode control element can be set to one mode or set of modes.* Thus, the mode control element, regardless of what type of element it is, is fully capable of being switched between modes. Within the scope of what is claimed

as a "switching element," Friesem, et al. thus, teaches some type of switching, wherein the mode control element can be switched between modes. Furthermore, the mode control element itself, therefore, may also be identified as the switching element, since it allows for the selection of a mode, allowing the modal composition of the radiation to be selected between such modes.

In addition, though Applicant argues that the switching element switches between the modes *during operation of the apparatus, the operation of the apparatus* is not what is claimed, only that a switching element be present to switch between modes. Thus, the one mode control element of Friesem, et al. is capable of selecting or switching between one or more modes. Furthermore, even if the claims were to include language stating that the switching occurred during operation of the apparatus, such a recitation is merely a process limitation imposed on the apparatus and does not distinguish the Applicant's apparatus from the prior art apparatus. Per MPEP 2114, "a claim containing a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus if the prior art apparatus teaches all the structural limitations of the claim. Ex parte Masham, 2 USPQ 2d 1647.

Therefore, after consideration of Applicant's arguments and a thorough review of the prior art previously cited, the Examiner maintains the rejection of claims 12 – 15.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARIA VERONICA D. EWALD whose telephone number is (571)272-8519. The examiner can normally be reached on M-F, 8 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Yogendra Gupta can be reached on 571-272-1316. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Yogendra N Gupta/
Supervisory Patent Examiner, Art Unit 1791

MVE